

### REMARKS/ARGUMENTS

Claims 1 and 3-39 are pending in this application. By this Amendment, Applicant amends Claims 1 and 21.

Claims 6, 11-20, 25 and 30-39 have been withdrawn from further consideration as being directed to non-elected species. Applicant respectfully submits that Claims 1 and 21 are generic. Since non-elected Claims 6, 11-20, 25 and 30-39 depend upon generic Claims 1 and 21, Applicant respectfully requests that the Examiner rejoin and allow Claims 6, 11-20, 25 and 30-39 when generic Claims 1 and 21 are allowed.

Claims 1, 3, 4, 8, 10, 21, 23, 27 and 29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Applicant's Admitted Prior Art Figure 8 (AAPA). Claims 5, 7, 9, 24, 26 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Bird et al. (U.S. 5,831,810). Applicant notes that Claim 22 has not been listed in either of the prior art rejections. However, since Claim 22 corresponds to Claim 3, it appears that the Examiner inadvertently omitted Claim 22 in the listing of claims rejected under 35 U.S.C. § 102(b) as being anticipated by AAPA. Applicant respectfully traverses the rejections of claims 1, 3-5, 7-10, 21, 23, 24 and 26-29.

Claim 1 has been amended to recite:

A multilayer ceramic substrate with a cavity comprising:  
a multilayer composite member including a plurality of ceramic layers disposed one on another;  
a cavity formed in the multilayer composite member such that an opening of the cavity is located in at least one principal surface of the multilayer composite member;  
a bottom-surface conductive film disposed on a bottom surface of the cavity;  
an electronic component disposed in the cavity;  
a capacitor conductive film disposed in the multilayer composite member such that the capacitor conductive film faces the bottom-surface conductive film via at least one ceramic layer; and  
**an electronic circuit disposed in the multilayer composite member;** wherein  
the bottom surface conductive film is connected to a ground potential;

the bottom-surface conductive film and the capacitor conductive film define a capacitor; and  
**a portion of the electronic circuit is connected to the ground potential through the capacitor defined by the bottom-surface conductive film and the capacitor conductive film.** (emphasis added)

Applicant's Claim 21 recites features that are similar to the features recited in Applicant's Claim 1, including the above-emphasized features.

The Examiner alleged that AAPA teaches all of the features recited in Applicant's Claims 1 and 21.

Claim 1 has been amended to recite the features of "an electronic circuit disposed in the multilayer composite member" and "a portion of the electronic circuit is connected to the ground potential through the capacitor defined by the bottom-surface conductive film and the capacitor conductive film." Claim 21 has been similarly amended. Support for these features is found, for example, on page 15, line 21 through page 16, line 16 of the originally filed specification.

As clearly seen in Prior Art Fig. 8 of AAPA, the multilayer ceramic substrate of AAPA does not include any electronic circuit that is disposed in the multilayer composite member 4 and certainly does not include any electronic circuit which is connected to a ground potential through any of the conductive films 9, 10 and 13. Thus, AAPA certainly fails to teach or suggest the features of "an electronic circuit disposed in the multilayer composite member" and "a portion of the electronic circuit is connected to the ground potential through the capacitor defined by the bottom-surface conductive film and the capacitor conductive film" as recited in Applicant's Claim 1, and similarly in Applicant's Claim 21.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 1 and 21 under 35 U.S.C. § 102(b) as being anticipated by AAPA.

The Examiner relied upon Bird et al. to allegedly cure a deficiency of AAPA. However, Bird et al. clearly fails to teach or suggest the features of "an electronic circuit

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disposed in the multilayer composite member” and “a portion of the electronic circuit is connected to the ground potential through the capacitor defined by the bottom-surface conductive film and the capacitor conductive film” as recited in Applicant’s Claim 1, and similarly in Applicant’s Claim 21. Thus, Applicant respectfully submits that Bird et al. fails to cure the deficiencies of AAPA described above.

Accordingly, Applicant respectfully submits that AAPA and Bird et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in Applicant’s Claims 1 and 21.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1 and 21 are allowable. Claims 3-5, 7-10, 22-24 and 26-29 depend upon Claims 1 and 21, and are therefore allowable for at least the reasons that Claims 1 and 21 are allowable.

In addition, non-elected claims 6, 11-20, 25 and 30-39 depend upon generic Claims 1 and 21. Accordingly, Applicant respectfully requests that the Examiner rejoin and allow non-elected Claims 6, 11-20, 25 and 30-39.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a Two-Month Extension of Time, extending to May 1, 2006, the period for response to the Office Action dated December 1, 2005.

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The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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